

Remarks

The Final Office Action dated November 27, 2009, lists the following rejections: claims 1-8 and 12-19 stand rejected under 35 U.S.C. § 103(a) over Erixon (U.S. Patent No. 7,233,678); claims 9-11 and 20 stand rejected under 35 U.S.C. § 103(a) over the '678 reference in view of Clark (U.S. Patent No. 6,134,336); and claim 1 is rejected on the ground of nonstatutory obviousness-type double-patenting over claim 1 of U.S. Patent No. 6,628,790. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 103(a) rejections because the Examiner has improperly relied on Official Notice without providing the required documentary evidence. In particular, the Examiner has improperly maintained these rejections without providing documentary evidence to support the Examiner's conclusion that a sound-delivery chamber (as in the claimed invention) is well-known, and readily combinable with the '678 reference, and without accommodating Applicant's express request that the Examiner provide such evidence (and reason for combining) in the previous Response. Moreover, the Examiner's issuance of a final rejection is particularly troubling in view of the Examiner's failure to respond to Applicant's request and in view of the fact Official Notice is not to be used in situations such as here when an application is under final rejection. *See, e.g.*, M.P.E.P. §§ 707.07(f) and 2144.03(A). Accordingly, the § 103(a) rejections are improper and must be withdrawn. The following discussion particularly addresses the impropriety of the rejections.

The cited Erixon '678 reference either alone or in combination with the Clark '336 reference lacks correspondence to the claimed invention. For example, neither of the asserted references teaches the claimed invention "as a whole" (§ 103(a)) including aspects regarding, *e.g.*, a sound-delivery chamber to amplify the sound conveyed into the acoustic free space relative to the sound conveyed into the space bounded by the ear. Because neither reference teaches these aspects, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence to the claimed invention. As such, the § 103(a) rejections fail.

More specifically, the Examiner acknowledges that the '678 reference does not teach a sound-delivery chamber as in the claimed invention. For the deficiencies of the '678 reference, the Examiner improperly relies upon Official Notice, attempting to assert that such a sound-delivery chamber is well-known without providing the documentary evidence required to support such a conclusion, and without identifying any reference and alleged motivation as would be proper for Applicant to consider and respond to the rejection. Consistent with M.P.E.P. § 2144.03, Applicant respectfully requests evidence in support of the proposition that such teachings are well known in the prior art and that there is adequate evidence of motivation to combine this prior art with the '678 reference. The Examiner makes multiple additional conclusions based upon Official Notice in an attempt to address various dependent claims, none of which are supported by documentary evidence as required (*see, e.g.*, the rejections of claims 8, 11, 16, 18 and 19). As the Examiner has failed to provide the required documentary evidence to support the rejections of these dependent claims, the rejections must be withdrawn.

Moreover, the claimed invention includes a sound-delivery chamber to amplify the sound conveyed into the acoustic free space relative to the sound conveyed into the space bounded by the ear. The Examiner's asserted sound-delivery chamber (channel 22 of the '678 reference), however, is connected directly to both opening 17 and opening 19 as shown in Fig. 6. As such, Applicant submits that the '678 reference is not capable of amplifying the sound conveyed through opening 19 (*i.e.*, into the asserted acoustic free space) relative to the sound conveyed through opening 17 (*i.e.*, into the asserted space bounded by the ear) because any amplification of the sound by channel 22 would be the same for the sound conveyed through both of the openings 17 and 19. Accordingly, neither the channel 22, nor the channel 22 being modified to be a chamber as proposed by the Examiner, corresponds to Applicant's sound-delivery chamber. In response to the Examiner's assertions in the instant Office Action regarding structural features, Applicant notes that the claimed sound-delivery chamber includes structural features to amplify the sound conveyed into the acoustic free space relative to the sound conveyed into the space bounded by the ear. As the Examiner has failed to cite to any reference that teaches any structure that amplifies the sound conveyed into the acoustic free space relative to the sound conveyed into the space bounded by the ear, the rejections necessarily fail.

Additionally, the '678 reference teaches away from modifying sound channel 22 into a chamber that amplifies the sound generated by speaker 16. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('678) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). In this instance, the '678 reference is directed to decreasing the size of the device and, in particular, to decreasing its thickness. *See, e.g.*, Col. 3:7-25. As such, the '678 reference teaches away from modifying sound channel 22 in a manner that would increase the size of the device, as proposed by the Examiner (*e.g.*, modifying channel 22 to be a chamber). The Examiner's response in the instant Office Action to Applicant's previous explanation regarding the impropriety of the proposed modification of the '678 reference mischaracterizes the teachings of the '678 reference and incorrectly states “Erixon only teaches reducing the size in one dimension, which is thickness (Col. 3, lines 21-23).” In contrast, the '678 reference expressly states that “it is an object to provide a speaker arrangement for a communication terminal making it possible to decrease the outer terminal dimensions.” Col. 3:7-12. Applicant highlighted this vary portion of the '678 reference in the previous Response. As such, the Examiner's mischaracterization of the '678 reference as “only” teaching reducing the thickness of the device is misleading at best.

The impropriety of the Examiner's proposed modification of the '678 reference is further highlighted by the rejections of various dependent claims in which the Examiner improperly attempts to modify the '678 reference to include additional chambers (*e.g.*, a sound-deflection chamber as in claim 10, and another sound-delivery chamber as in claims 16-20). Such modifications would substantially increase the size and thickness of the device taught by the '678 reference and, as such, the '678 reference teaches away from these modifications. Applicant previously explained the impropriety of the Examiner's proposed modifications of the '678 reference with regard to the rejections of

claims 10 and 16-20, to which the Examiner failed to respond as required, for example, by M.P.E.P. § 707.07(f).

In view of the above, the § 103(a) rejections are improper and Applicant requests that they be withdrawn.

Applicant respectfully traverses the obviousness-type double-patenting rejection of claim 1 over claim 1 of U.S. Patent No. 6,628,790. Specifically, claim 1 of the '790 patent does not include a sound-delivery chamber to amplify the sound conveyed into the acoustic free space as in the claimed invention. The Examiner improperly relies upon Official Notice in attempting to assert that such a sound-delivery chamber is well-known without providing the documentary evidence required to support such a conclusion. *See, e.g.,* M.P.E.P. § 2144.03 discussed above. Thus, the obviousness-type double-patenting rejection fails for the same reasons discussed above in relation to the Examiner's improper use of Official Notice in connection with the § 103(a) rejections. Accordingly, the obviousness-type double-patenting rejection of claim 1 is improper and Applicant requests that it be withdrawn.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Schaeffer, of NXP Corporation at (212) 876-6170 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Robert J. Crawford
Reg. No.: 32,122
651-686-6633
(NXPS.562PA)